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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,130	01/07/2002	Clifford A. Pickover	YOR920010296US1	2408

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EXAMINER
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LANEAU, RONALD

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

## Application No.

10/041,130

## Applicant(s)

PICKOVER ET AL.

## Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. Claims 1-52 are presented for examination.

#### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 12 and 22 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for item that cannot be disassociated from the cart in paragraph [0081], lines 7-8, does not reasonably provide enablement for not disassociating the item from the cart. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Claims 12 and 22 simply recite the exact wording of the specification and no explanation was given as to how the applicant intends to carry this part of the invention. It is the Examiner's understanding that once an associated item is sent to a shopping cart and said particular associated item is not selected by the consumer, said consumer has a right to remove the associated item from the shopping cart if said item is not of interest of said consumer. By not allowing the consumer to remove said associated item as the applicant claims "item cannot be disassociated from the shopping cart," consumer is left with no options whatsoever as to remove said associated item. Applicant has not provided ample details as to what happens to an item associated to the shopping cart assuming that a consumer does not want to purchase said

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associated item and is unable to remove it from the shopping cart. It looks like consumer might be forced to purchase an item that cannot be disassociated from the shopping cart. This is a legitimate concern from a consumer's point of view that is raised by the Examiner and applicant is required to provide details as to non-disassociation or non-removal of an associated item from a shopping cart.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-11, 13-19, 21, 23-41 and 43-51 are rejected under 35 U.S.C. 102(e) as being anticipated by McAuliffe (US 2003/0004798).

As per claims 1-11, 13-17, 23-41 and 43-51, McAuliffe discloses a method for online shopping (electronic commerce), including the steps of: associating an online shopping cart with a consumer (page 11, [0007], lines 1-8); consumer selects the items to place in the shopping cart and consumer is associated to the shopping cart); and associating an item with the online shopping cart (page 3, [0024], lines 8-12); items are stored in the shopping cart and are therefore associated to the shopping cart), wherein the associated item was not selected by the consumer for association with the shopping cart (page 1, [0007], lines 10-13; the system provides consumer with an opportunity to buy additional items that were not selected with an enticement).

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McAuliffe further discloses a method wherein the item is associated with the shopping cart based on at least one of: a shopping history of the consumer (page 4, [0038], lines 10-13); a method further comprising: determining to associate the item with the online shopping cart based on a first item associated with the shopping cart (page 1, [0008], lines 14-16), wherein the item is complementary to the first item (page 1, [0007], lines 11-13); wherein the item is a substitute for the first item (page 1, [0007], lines 14-17); comprising: determining to associate the item with the online shopping cart based on a characteristic of items previously associated with the shopping cart (page 1, [0007], lines 14-17); wherein the characteristic comprises at least a type of one or more of the items (page 3, [0029], lines 6-8); including the step of determining to associate the item with the online shopping cart based on a characteristic (behavior) of the consumer (page 3, [0029], lines 9-10); wherein the characteristic comprises at least one shopping history (page 4, [0038], lines 11-14); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price of the item being offered for sale i.e. less than a retail cost). McAuliffe does not disclose a charge for associating an item into the shopping cart for consumers to purchase i.e. the cost of the associated item must be free as claimed. Furthermore, McAuliffe discloses a method further comprising: receiving an instruction from the consumer to disassociate a second item from the shopping cart; and in response to the instruction, automatically disassociating the item from the shopping cart (page 1, [0009], lines 3-12; upon consumer's return of item, entitlement is altered to disassociate the second item from the shopping cart); comprising: presenting terms (financing term) for purchasing the item to the consumer (page 3, [0029], lines 16-19); further comprising

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determining the association based on rules (page 2, [0012], lines 3-7); comprising: dynamically updating the rules (page 3, [0025], lines 18-20); further comprising: notifying the consumer that the item was associated with the shopping cart (page 5, [0041], lines 8-14);

As per claim 18, 19 and 21, McAuliffe discloses a method for online shopping (electronic commerce), comprising: associating an online shopping cart with a consumer (page 11, [0007], lines 1-8); and associating an item with the online shopping cart (page 3, [0024], lines 8-12) in response to a selection of the item by an entity other than the consumer (page 1, [0007], lines 10-13; entity = merchant = seller); wherein the entity is a potential seller (merchant) of the item (potential seller = merchant); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price of the item being offered for sale i.e. less than a retail cost). Furthermore, McAuliffe discloses a method further comprising: receiving an instruction from the consumer to disassociate a second item from the shopping cart; and in response to the instruction, automatically disassociating the item from the shopping cart (page 1, [0009], lines 3-12; upon consumer's return of item, enticement is altered to disassociate the second item from the shopping cart).

As per claims 43-51, McAuliffe discloses an apparatus for electronic shopping (electronic commerce), comprising: a processor (fig. 2, engine 210); and a storage device in communication with the processor and storing instructions adapted to be executed by the processor (page 3, [0027], lines 6-10) to: associate an online shopping cart with a consumer (page 11, [0007], lines 1-8); and associate an item with the online shopping cart (page 3, [0024], lines 8-12), wherein the associated item was not selected by the consumer for association with the shopping cart

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(page 1, [0007], lines 10-13; the system provides consumer with an opportunity to buy additional items that were not selected with an enticement). McAuliffe further discloses a method wherein the item is associated with the shopping cart based on at least one of: a shopping history of the consumer (page 4, [0038], lines 10-13); a method further comprising: determining to associate the item with the online shopping cart based on a first item associated with the shopping cart Page 1, [0008], lines 14-16), wherein the item is complementary to the first item (page 1, [0007], lines 11-13); wherein the item is a substitute for the first item (page 1, [0007], lines 14-17); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price of the item being offered for sale i.e. less than a retail cost); wherein the entity is a potential seller of the item (potential seller = merchant). McAuliffe does not disclose a charge for associating an item into the shopping cart for consumers to purchase i.e. the cost of the associated item must be free as claimed.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 20, 42 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAuliffe (US 2003/0004798) in view of Batachia et al (US 2002/0116349).

As per claims 20, 42 and 52, McAuliffe does disclose an intelligent buyer agent 290 in fig. 2) but does not disclose a merchant or an entity other than the consumer using an intelligent agent but Batachia is used to show that the concept of utilizing an intelligent between the consumers and the merchants is old and well known in the art.

It would have been obvious to one of ordinary skill in the art to utilize the intelligent agent as taught by Batachia into the system of McAuliffe because it would improve the negotiation capability between consumers and merchants and also enable to operate reliably, efficiently and profitably on behalf of their clients (merchants or consumers).

### ***Conclusion***

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Spiegel et al (US 6,629,079 B1) disclose a method and system for electronic commerce providing multiple shopping carts for each user.
- Jacobi et al (US 6,317,722 B1) disclose the use of electronic shopping carts to generate personal recommendations.
- Linden et al (US 2002/0019763 A1) disclose the use of product viewing histories of users to identify related products.
- Allard et al (US 6,249,773 B1) disclose an electronic commerce with shopping list builder.
- Amensen et al (US 2003/0115107 A1) disclose a method and system for cart transfer in electronic commerce.

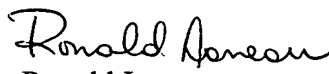


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Ronald Laneau  
Examiner  
Art Unit 3627

1/21/05

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